

REMARKS

Responsive to the Office communication mailed March 28, 2005, Applicants provide the following remarks.

Initially, Applicants, through the undersigned, wish to thank Practice Specialist Michael Woodward for the courtesy and assistance provided in connection with this submission suggested by Mr. Woodward in a telephone conference conducted on September 22, 2005. In addition, the continued assistance of Examiner Saoud is greatly appreciated.

According to a succession of prior Office communications dating back to June 1, 2001, all pending claims in the present application are allowable, although *ex parte* prosecution was suspended pending the analysis of a potential interference. On March 28, 2005, Applicants received a further Office communication termed "Interference" requiring Applicants, pursuant to recently promulgated rule 37 C.F.R. §41.202(c), to comply with requirements set forth in 37 C.F.R. §§41.202(a)(2)-(a)(6).

Pursuant to 37 C.F.R. §§41.202(5) and (6) none of the claims in issue have been added or amended to provoke an interference. Applicants are presently analyzing their priority position relative to the priority date on the face of U.S. Patent No. 5,928,939 (the '939 patent), i.e. March 1, 1995, identified by Examiner Saoud as an interfering patent; however, applicants require additional time, *inter alia*, to confirm that the disclosure of the priority document provides a constructive reduction to practice within the scope of the interfering subject matter. Notably, in the midst of the time frame for response, Applicants have become aware of a **third party** application from Human Genome Sciences (U.S. Serial No. 08/469,641) that may also impact the prospective determination of the proposed interference. According to public PAIR, on March 28, 2005 (the same date Examiner Saoud mailed the instant Office communication),

the Examiner sent an Office communication to Human Genome Sciences (HGS) relating a potential interference with Claim 1 of the '939 patent identified by the PTO and hereinabove.

The HGS Application presents claims directed to an isolated nucleic acid encoding a molecule called VEGF3 which nucleic acid molecule is apparently deposited as ATCC NO. 97166. The deposited HGS cDNA clone is suspected of evidencing the same sequence as the DNA encoding VEGF-B, the subject matter of the present application. If confirmed, this information could compel the inclusion of all three parties (AMRAD, HGS and The Ludwig Institute for Cancer Research (LICR)) in an interference. Until such sequence information relating the deposited clone is confirmed¹, it may be prejudicial to Applicants (and to all parties, in fact) to be required to make any affirmative assertion relative to its priority date given the undetermined scope of the controversy. Further, a position taken in the present case may be used against Applicants in a subsequent interference if the subject matter of the claims of HGS, AMRAD and LICR are in conflict, as it would presently appear.

Furthermore, Applicants have become aware of a second HGS application (US Serial No. 09/033,662; the '662 application which includes claims that rely on the deposited cDNA clone described above. (Prosecution of the HGS '662 counterpart application in the EPO has been reviewed by the Applicants which reveals that HGS is aware of AMRAD's VEGF-B; HGS now indicates that VEGF-B is also known as VEGF3). Prosecution on the HGS '662 application has been suspended according to PAIR.

Inasmuch as 37 C.F.R. §41.202(4) requires the Applicants to "explain in detail why the applicants will prevail on priority" and Applicants have demonstrated the practical impossibility of complying with such a requirement without more knowledge of the status of the HGS sequence, a further suspension of the present *ex parte* prosecution is warranted in the

¹ Note: the Applicants have requested the clone from the ATCC

present circumstance. A suspension will permit Applicants to confirm the sequence of the HGS clone and then respond to the requirements at issue, perhaps in view of an additional party.

Finally, claims 54-59 have been added to further define the subject matter to which Applicants are entitled in the present application. Support for claims 54-59 is found throughout the specification and particularly at page 4, lines 30-32, page 6, line 17-18, page 7, lines 22-26, page 10, lines 17-21 and page 25, lines 3-6. No new matter has been added.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'F. DiGiglio', is positioned above the printed name.

Frank S. DiGiglio
Registration No. 31,346

Scully, Scott, Murphy & Presser
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
PIB/FSD:dg